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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,071	12/11/2003	Stuart Herskovitz	QOS P-5REI/500623.20002	8899
32137 7590 03/16/2009 PATENT DOCKET CLERK COWAN, LIEBOWITZ & LATMAN, P.C. 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER BENNETT, GEORGE B	
			ART UNIT 2841	PAPER NUMBER
			MAIL DATE 03/16/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/734,071

**Applicant(s)**

HERSKOVITZ, STUART

**Examiner**

G. Bradley Bennett

**Art Unit**

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 11 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Reissue Applications***

1. The indicated allowability of claims 10-15 is withdrawn in view of the newly discovered recaptured material and new matter. Rejections based on the newly cited information follow.

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show that the bar of soap is transparent only to the depth of the grid as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 10 includes the phrase "said bar of soap transparent to at least the depth of said grid." This feature had not previously been disclosed and is considered to be "new matter." Additionally, the new last limitation is not a materially narrowing limitation because a transparent bar of soap is, by definition of the word "transparent," (transmitting light rays so that objects on the other side may be distinctly seen; capable of being seen through; as, window glass is *transparent*: opposed to *opaque* and distinguished from "*translucent*"- Webster's New Twentieth Century Dictionary - Unabridged - Second Edition 1979, at page 1940) completely transparent. It cannot be transparent only to a particular depth, otherwise it would be translucent or opaque. Furthermore, if the bar of soap were not entirely transparent, the device couldn't function for its disclosed purpose. If one puts the bar of soap on one's arm over a mole on one's skin, and the bar of soap is only transparent to at least the depth of the grid, one cannot see the mole located beneath the grid, and so cannot measure growth of the mole. Additionally, the illustrations are of a completely transparent device. If the bar of soap were not entirely

transparent, the device couldn't function for its disclosed purpose. If one puts the bar of soap on one's arm over a mole on one's skin, and the bar of soap is only transparent to at least the depth of the grid, one cannot see the mole located beneath the grid, and so cannot measure growth of the mole.

*Rejection Under Recapture Doctrine*

4. Originally filed claims 1-10 included two independent claims (1 and 6). Both claimed an embedded grid, but neither required that the grid include "square" cells. Dependent claims 4 and 5 (depending from claim 1) and dependent claims 8 and 9 (depending from claim 6) recited the square limitation.
5. The 1st Office action rejected all claims.
6. Applicant's response was to cancel claims 1-10 in favor of claims 11-19. Claims 11 and 15 were the new independent claims. Each included the "square" cell limitation. In the remarks, applicant stated (at page 3 of the 6/11/01 REM paper) that: "Applicant has submitted a new set of claims 11 through 19 in recognition of the fact that the effectiveness of this device to achieve the purpose discussed above calls for the bar of soap embodiment in which **square cells are employed**." (emphasis added).
7. The broadest new claim calls for at least one square cell because in a minimalist form, Applicant's invention could be incorporated by someone providing a single square cell. Applicant considers such to be a non-preferred embodiment but believes that a claim having this type of embodiment is warrant. Dependent claims refer to the device having a plurality of square cells.

8. It is clear that applicant has limited the use of a grid in a medium (which in turn is now limited to a transparent bar of soap) to be a grid that utilizes square cells.

9. Following the next rejection, applicant added new claim 20, which included the "at least one square cell" limitation and the further limitation that "said cell being of a size adapted to facilitate obtaining an indication of the extent of growth of a skin abnormality." The accompanying remarks state that: "[T]he gravamen of the inventive contribution in this case is the recognition that a particular structure (the grid and a bar of soap) can be usefully adapted to facilitate the ready identification of growth of skin abnormality."

10. Turning now to the reissue application, the sole error statement is that: The original claims do not appreciate the full scope of the invention and therefore reissue is requested to add broader claims. In particular, the limitation to the geometry of the cell (i.e., claiming is [sic, "it"] as a square cell) is too limiting."

11. It was noted that where a claim removes a limitation that was added/argued to obtain patentability, there is a *prima facie* case of recapture.

12. Furthermore, a *prima facie* case of recapture could be overcome if the claim in question was also amended to include a "materially narrowing limitation," i.e., a limitation that had never been claimed at before. A review of new independent claim 10 (the sole independent claim proposed in the reissue application) shows that claim 10 is identical to the sole independent claim in the patent, except that it calls for "one center cell" instead of "one square cell," and it includes a new last limitation in the claim: "said bar of soap transparent to at least the depth of said grid."

13. That new last limitation is not a materially narrowing limitation because a transparent bar of soap is, by definition of the word "transparent, " (transmitting light rays so that objects on the other side may be distinctly seen; capable of being seen through; as, window glass is *transparent*: opposed to *opaque* and distinguished from "*translucent*"- Webster's New Twentieth Century Dictionary - Unabridged - Second Edition 1979, at page 1940) completely transparent. It cannot be transparent only to a particular depth, otherwise it would be translucent or opaque. Furthermore, if the bar of soap were not entirely transparent, the device couldn't function for its disclosed purpose. If one puts the bar of soap on one's arm over a mole on one's skin, and the bar of soap is only transparent to at least the depth of the grid, one cannot see the mole located beneath the grid, and so cannot measure growth of the mole. Additionally, the illustrations are of a completely transparent device. If the bar of soap were not entirely transparent, the device couldn't function for its disclosed purpose. If one puts the bar of soap on one's arm over a mole on one's skin, and the bar of soap is only transparent to at least the depth of the grid, one cannot see the mole located beneath the grid, and so cannot measure growth of the mole.

14. Therefore, a rejection of claims 10-15 under the recapture doctrine is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to G. Bradley Bennett whose telephone number is 571.272.2237. The examiner can normally be reached on M-TH 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A. Reichard can be reached on 571.272.1984. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866.217.9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800.786.9199 (IN USA OR CANADA) or 571.272.1000.

/G. Bradley Bennett/

G. Bradley Bennett  
Primary Examiner  
Art Unit 2841

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